

REMARKS

In response to the Notice of Panel Decision from Pre-Appeal Brief Review mailed February 2, 2009 and the Final Office Action mailed October 17, 2008 (hereinafter "Office Action"), claims 1, 2, 9, 36, 71, 102, 133 and 153 have been amended. No claims have been newly added. Support for the instant amendments is provided throughout the embodiments disclosed in the originally filed Specification. Thus, no new matter has been added. Therefore, claims 1-134 and 136-153 are pending, of which claims 11-13, 17-22, 48, 52-57, 82-83, 99, 101, 113-114, 130 and 132 remain withdrawn.

In view of the following comments, allowance of all the claims pending in the application is respectfully requested.

As a preliminary matter, Applicants note that the substance of this Amendment and its corresponding remarks are essentially the same as those filed in the Response on July 21, 2009, other than correction of minor clerical errors noted by the Examiner in the Notice of Non-Compliant Amendment mailed October 13, 2009.

Rejections under 35 U.S.C. § 103

- Claims 1-10, 14-16, 23-45, 49-51, 58-81, 84-98, 100, 102-112, 115-129, 131, 133, 134 and 136-146 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,803,500 to Mossberg ("Mossberg") in view of U.S. Patent No. 5,909,673 to Gregory ("Gregory") and U.S. Patent No. 5,845,256 to Woolston ("Woolston").
- Claims 147 and 148 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Mossberg in view of Gregory and Woolston and further in view of the Official Notice taken ("Official Notice").
- Claims 149-153 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Mossberg in view of Gregory, and Woolston, and further in view U.S. Patent No. 6,112,181 to Shear ("Shear").

Applicants disagree with the propriety of these rejections. However, solely in an effort to expedite prosecution, Applicants have amended independent claims 1, 36, 71, 102, 133 and 153 to further clarify and broaden some aspects of the claimed invention.

A. Claim 1 is patentable under 35 U.S.C. § 103(a) over Mossberg, Gregory, and Woolston, either alone or in combination.

1. Mossberg, Gregory, and Woolston each fail to teach (i) a business having peak and non-peak demand periods; and (ii) an item that is redeemable for the service from a businesses during a non-peak demand period to obtain a discount from the predetermined price of the item during the non-peak demand period.

The Examiner *acknowledges* that "Mossberg fails to disclose ... [that] the discounted gift certificates are redeemable for the service from a corresponding one of the one or more restaurants during the non-peak demand period."¹ However, the Examiner alleges that Gregory teaches providing coupons that are redeemable for the service during non-peak demand periods to reduce excess capacity during non-peak demand periods.² The Examiner has legally erred for *at least* the reason that the Examiner mischaracterizes Gregory.

The relied-upon passage of Gregory discloses:

The hardware used to implement the system described above can also be used to distribute site specific coupons. Site specific coupons are coupons targeted to the requirements of individual stores including specific details like the amount of the discount on the coupon, the days and hours the coupon is valid, the location at which the coupon is valid, the expiration date of the coupon, and the product to which the coupon applies. In the prior art method of distributing coupons the needs of individual stores cannot be taken into account. The present invention allows retailers or restaurants to customize coupons for specific locations. For example, *if a certain product does not sell well at a particular location a coupon can be distributed that provides a greater discount at that location than the discount provided at other locations.*³ (emphasis added)

¹ Office Action, pgs. 3-4.

² See Office Action, pgs. 4-5 (*citing* col. 6, lines 54-67 of Gregory).

³ Gregory, col. 6, lines 54-67.

Gregory focuses on using coupons at different locations. To the extent that Gregory provides businesses with the ability to set "the days and hours the coupon is valid," Gregory makes no mention or suggestion that these periods are non-peak demand periods of businesses, as claimed. For example, the days and hours that a coupon is valid may correspond to the hours of operations of the business. Gregory further teaches the businesses may provide discounts on products not selling well, but this is done on a location-by-location basis, not on a temporal basis. These are not the same. Gregory does not disclose any solutions for businesses to reduce excess capacity *during non-peak demand periods*. Thus, it does not follow that Gregory teaches or otherwise renders obvious enabling businesses to reduce excess capacity at non-peak demand periods using coupons redeemable at non-peak time.

Woolston does not overcome these deficiencies, either, as further discussed below.

For *at least* the foregoing reasons, the rejection of claim 1 is improper and should be withdrawn.

2. Mossberg, Gregory and Woolston each fail to teach providing an auction posting module for enabling one or more businesses to post on the web-site at least one item for auction, including restrictions comprising valid dates and times for use of the at least one item, the restrictions corresponding to a non-peak demand period of a business to reduce excess capacity of that business during the non-peak demand period.

The Examiner *acknowledges* that "Mossberg in view of Gregory fails to disclose enabling one or more restaurants to post on the web site a listing of one or more discounted gift certificates being offered for sale and further information regarding valid dates and times for use of the one or more discounted gift certificates to reduce excess capacity during the non-peak demand periods at the time of the post ..."4

However, the Examiner asserts that Woolston teaches listing descriptive information at the time of the post and that "... the descriptive information is a matter of design choice (e.g., valid dates and times for use of the one or more discounted gift certificates to reduce excess

capacity during the non-peak demand period)."⁵ The Examiner has legally erred for *at least* the reasons that (i) the Examiner ignores the plain language of the claim; (ii) fails to consider the "subject matter as a whole," under 35 U.S.C. § 103; and (iii) the recitation is not a matter of design choice.

Claim 1 does not just recite that the posts include any descriptive information regarding the item. Rather, claim 1 specifically recites "providing an auction posting module for enabling one or more businesses to post on the web-site at least one item for auction, including restrictions comprising valid dates and times for use of the at least one item, the restrictions corresponding to a non-peak demand period of a business to reduce excess capacity of that business during the non-peak demand period."

Indeed, "[t]he [Examiner] must consider all claim limitations when determining patentability of an invention over the prior art."⁶ Even if the recitation might include descriptive matter (which Applicants do not concede), it is improper to disregard a recitation, just because it might be comprised of descriptive matter.⁷

As such, the Examiner's treatment of the recitation fails to consider the subject matter as a whole. "Under section 103, the [Examiner] cannot dissect a claim, excise the [descriptive] matter from it, and declare the remaining portion of the mutilated claim to be unpatentable."⁸ Indeed, the Examiner must give patentable weight to the descriptive matter where the descriptive matter and the claimed invention are so interrelated that there is a functional relationship between the descriptive matter and the claimed invention.⁹ In fact, claim 1 also recites that "... the item is redeemable for the service from a corresponding one of the one or more businesses *during the non-peak demand period for a discount, subject to the*

⁴ Office Action, pg. 5.

⁵ *Id.* pg. 5; *see also* pgs. 6-7 (similar treatment of the features of claims 136 and 138).

⁶ *In re Lowry*, 32 F.3d 1579, 1582, 32 USPQ2d 1021, 1034 (Fed. Cir. 1994) (citation omitted) (emphasis added).

⁷ *See In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 403 (Fed. Cir. 1983).

⁸ *Id.*

⁹ *See, e.g., Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035; *In re Ngai*, 367 F.3d 1336, 70 USPQ2d 1862 (Fed. Cir. 2004); *Gulack*, 703 F.2d at 1385, 217 USPQ at 404; *In re Miller*, 418 F.2d 1392, 1396, 164 USPQ 46, 48-49 (CCPA 1969).

restrictions, and non-winners and non-purchasers pay the predetermined price without the discount during the non-peak demand period.”¹⁰ Thus, the auction posting module enables businesses, when posting, to specifically inform users of the dates and times that items are redeemable at a discount. Without this information, users would not be apprised of time-sensitive discounts.

The prior art does not teach or render obvious these features. For example, Woolston is silent with regard to enabling a business to post on a web-site one or more items for auction, including restrictions comprising valid dates and times for use of the one or more items at the non-peak demand period, the restrictions correspond to a non-peak demand period of a business to reduce excess capacity of that business during the non-peak demand period. To the extent that the system of Woolston enables posting a date or time, it is the date and time at which an auction for the item posted is to occur.¹¹ This is not relevant to reducing excess capacity that businesses face during non-peak demand periods.

By contrast, according to Applicants’ claimed invention, it is the recognition that for different businesses and restaurants peak and non-peak demand periods may vary that the invention provides a flexible system for businesses (and restaurants) to establish restrictions of the dates and times that users can obtain a discount corresponding to the non-peak demand periods. According to a further aspect of the invention, a web-site is provided that enables businesses to post items for auction or instant purchase, such that auction winners and instant purchasers can obtain a discount from the predetermined price during non-peak demand periods, subject to the restrictions. This provides businesses with a greater ability to reduce excess capacity during off-peak times. Thus, the recitation is not an obvious matter of design choice.¹²

¹⁰ The preamble of the claim 1 also recites: “A computer implemented method of using a web-site for **reducing excess capacity during non-peak demand periods** for a service business **that experiences periods of peak demand and periods of non-peak demand for a service** that is offered at a predetermined price ...” (emphasis added).

¹¹ See Woolston, col. 5, lines 60-62; col. 6, lines 3-5.

¹² See *In re Chu*, 66 F.3d 292, 298-99, 36 USPQ2d 1089, 1094-96 (Fed. Cir.1995) (holding only if applicant fails to set forth any reasons why the differences between the claimed invention and the prior art would result in a different function or give unexpected results, might the differences be a matter of design choice).

For *at least* the foregoing reasons, the rejection of independent claim 1 under 35 U.S.C. § 103(a) in view of Mossberg, Gregory and Woolston is improper and should be withdrawn. Dependent claims 2-35 are patentable because they depend from independent claim 1, as well as for the additional features they recite individually.

B. The alleged combination of Mossberg, Gregory and Woolston fails to teach or otherwise render obvious all the features of independent claim 36.

Independent claim 36 recites, *inter alia*, the features of:

a business module for enabling one or more businesses to post on the web-site at least one item for auction, including restrictions comprising valid dates and times for use of the at least one item, the restrictions corresponding to a non-peak demand period of a business to reduce excess capacity of that business during the non-peak demand period.

Independent claim 36 recites system recitations substantially corresponding to the method steps of independent claim 1.

For reasons that should be quite apparent from the discussion of independent claim 1, above, Mossberg, Gregory, and Woolston, either alone or in combination, do not teach or otherwise render obvious these features of independent claim 36.

For *at least* the foregoing reasons, the rejection of independent claim 36 under 35 U.S.C. § 103(a) in view of Mossberg, Gregory and Woolston is improper and should be withdrawn. Dependent claims 37-70, are patentable because they depend from independent claim 36, as well as for the additional features they recite individually.

C. The alleged combination of Mossberg, Gregory and Woolston fails to teach or otherwise render obvious all the features of independent claims 71 and 102.

Independent claim 71 recites, *inter alia*, the features of:

providing a web site for enabling one or more businesses to post an offer to auction at least one certificate, the at least one certificate having a predetermined value and being redeemable for services from a corresponding one of the one or more businesses, including restrictions comprising valid dates and times for use of the at least one certificate, the restrictions corresponding to a non-peak demand period of a business to reduce excess capacity of that business during the non-peak demand period.

Similarly, independent claim 102 recites:

an auction posting module for enabling a business to post on the web site an offer to auction at least one certificate, the at least one certificate having a predetermined value and being redeemable for services from the business, including restrictions comprising valid dates and times for use of the at least one certificate, the restrictions corresponding to a non-peak demand period of a business to reduce excess capacity of that business during the non-peak demand period.

Independent claims 71 recites subject matter similar to independent claim 1, but recites "certificates," not just items. Independent claim 102 recites system recitations substantially corresponding to the method steps of independent claim 71.

For reasons that should be quite apparent from the discussion of independent claim 1, above, Mossberg, Gregory, and Woolston, either alone or in combination, do not teach or otherwise render obvious these features of independent claims 71 and 102.

Dependent claims 72-101 and 103-132 are patentable because they depend from the independent claims 71 and 102, as well as for the additional features they recite individually.

D. The alleged combination of Mossberg, Gregory and Woolston fails to teach or otherwise render obvious all the features of independent claim 133.

Independent claim 133 recites, *inter alia*, the features of:

providing an auction posting module for enabling one or more of the restaurants to post on the web site a listing of at least one discounted gift certificate being offered for sale, including

restrictions comprising valid dates and times for use of the at least one discounted gift certificate, the restrictions corresponding to a non-peak demand period of a restaurant to reduce excess capacity of that restaurant during the non-peak demand period.

Independent claim 133 recites subject matter similar to independent claim 1, but is directed more narrowly to “reducing capacity for one or more restaurants,” not just businesses, and recites “gift certificates” rather than items.

For reasons that should be quite apparent from the discussion of independent claim 1, above, Mossberg, Gregory, and Woolston, either alone or in combination, do not teach or otherwise render obvious these features of independent claim 133.

Dependent claims 134 and 136-152, are patentable because they depend from the independent claim 133, as well as for the additional features they recite individually.

E. The alleged combination of Mossberg, Gregory, and Woolston and further in view of Shear fails to teach or otherwise render obvious all the features of independent claim 153.

Assuming, *arguendo*, that it were legally proper to further modify the combination of Mossberg, Gregory, and Woolston, based on the teachings of Shear (which Applicants do not concede), the combination of Mossberg, Gregory, Woolston and Shear fails to disclose or otherwise render obvious each and every feature recited in independent claim 153.

Independent claim 153 recites, *inter alia*, the features of:

a restaurant listing module, the listing module enabling one or more restaurants to post on the web site a listing offering at least one discounted gift certificate for sale according to a cuisine type, zip code, or geographic area parameter, including restrictions comprising valid dates and times for using the at least one discounted gift certificate, the restrictions corresponding to a non-peak demand period of a restaurant to reduce excess capacity of that restaurant during the non-peak demand period.

Independent claim 153 recites system recitations substantially corresponding to the method steps of independent claim 133. For reasons that should be quite apparent from the discussion of independent claims 1 and 133, above, Mossberg, Gregory, and Woolston, either alone or in combination, do not teach or otherwise render obvious these features of independent claim 153.

Shear does overcome the deficiencies of Mossberg, Gregory, and Woolston either. For example, Shear was relied upon by the Examiner only to allegedly teach a restaurant search module.¹³

For *at least* the foregoing reasons, the rejection of independent 153 under 35 U.S.C. § 103(a) over Mossberg, Gregory, Woolston and further in view of Shear is improper and should be withdrawn.

¹³ See Office Action, pg. 9.

CONCLUSION

Having addressed each of the foregoing rejections, it is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, the application is in condition for allowance. Notice to that effect is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Date: **November 12, 2009**

Respectfully submitted,

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